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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SORKIN, DAVID L

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/062,431

Applicant(s)

WINKLER ET AL.

Examiner

David L. Sorkin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 41-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 41-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 41-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. In claims 41 and 42, it is unclear if the "polymer array" is part of the claimed structure, or if the polymer array refers to contents of the apparatus during an intended operation.
4. In claim 43, there is lack of antecedent basis for "the probe array".
5. In claim 43, the scope of the relative term "closely" is unclear.
6. In claim 43, the scope of the relative term "narrow" is unclear.
7. In claim 44, it is unclear what range of angles is being recited. The specification provides insufficient information for understanding the scope of structures corresponding to this functional limitation. Also, claim 44 appears to contradict base claim 42, which implies the walls are perpendicular to the axis of rotation.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 41-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Wells (US 423,362). Regarding claim 41, Wells ('362) discloses a holding device comprising a body (A) having a rotational axis, a pair of end members extending from the axis, and one or more walls extending between the end members parallel to the axis (see Fig. 2); at least one coupling member (E, B'). Regarding claim 42, Wells ('362) discloses a system comprising a container (B,C); and a holding device comprising a body (A) having a rotational axis, a pair of end members extending from the axis, and one or more walls extending between the end members parallel to the axis (see Fig. 2); at least one coupling member (E, B'). While the scope of claim 43 is unclear as discussed above, the container defines a chamber including a pair of spaced apart faces (C and the closed end of B), that are separated by walls (the side walls of B), wherein one of the faces (C) defines a planar surface. Regarding claim 44, the walls of the chamber are set at angles sufficient to agitate fluid when rotated (see Fig. 2). Claims 45 and 46 fail to further structurally limit the claimed apparatus. Regarding claim 47, the end members are perpendicular to the walls (see Fig. 2).

10. Claims 41, 42, and 44-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Shumway (US 493,046). Regarding claim 41, Shumway ('046) discloses a holding device comprising a body having a rotational axis, a pair of end members (B) extending from the axis, and one or more walls (A,C,D) extending between the end members parallel to the axis (see Figs. 1 and 2); at least one coupling member (see col. 1, lines 44-47, Fig. 2). Regarding claim 42, Wells ('362) discloses a system comprising a container (see col. 1, lines 44-47, Fig. 2); and a holding device comprising a body

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having a rotational axis, a pair of end members (B) extending from the axis, and one or more walls (A,C,D) extending between the end members parallel to the axis (see Fig. 2); at least one coupling member (see col. 1, lines 44-47, Fig. 2). Regarding claim 44, the walls of the chamber are set at angles sufficient to agitate fluid when rotated (see Figs. 1 and 2). Claims 45 and 46 fail to further structurally limit the claimed apparatus. Regarding claim 47, the end members are perpendicular to the walls (see Figs. 1 and 2). Regarding claim 48, the coupling members comprise a pair of rails fixedly attached to the walls to form a slot for the container (see Fig. 2). Regarding claim 49, the rails are perpendicular to the walls (see Fig. 2).

11. Claims 41, 42 and 44-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Neuner et al. (US 4,329,068). Regarding claim 41, Neuner ('068) discloses a holding device (26) comprising a body having a rotational axis, a pair of end members (32) extending from the axis, and one or more walls (28,34,40) extending between the end members parallel to the axis (see Figs. 1 and 2); at least one coupling member (for example, 14 or 30). Regarding claim 42, Wells ('362) discloses a system comprising a container (see col. 1, lines 44-47, Fig. 2); and a holding device comprising a body having a rotational axis, a pair of end members (B) extending from the axis, and one or more walls (A,C,D) extending between the end members parallel to the axis (see Fig. 2); at least one coupling member (for example, 14 or 30). Regarding claim 44, the walls of the chamber are set at angles sufficient to agitate fluid when rotated (see Figs. 1 and 2). Claims 45 and 46 fail to further structurally limit the claimed apparatus.

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Regarding claim 47, the end members are perpendicular to the walls (see Figs. 1 and 2).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Neuner et al. (US 4,329,068) in view of Reynolds et al. (5,753,187). The holding device of Neuner ('068) discussed above with regard to claim 42, while rotatable disposed, is not disposed in an oven. Reynolds ('187) explains that is known to disposed rotatable holding devices in the an oven for the purpose of controlling temperature of chemical and biological experiments (see col. 1, lines 11-35). It is considered that it would have been obvious to one of ordinary skill in the art to have disposed the device of Neuner

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('068) in an oven to controlling temperature of chemical experiments as taught by Reynolds ('187), col. 1, lines 11-35.

**Conclusion**

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

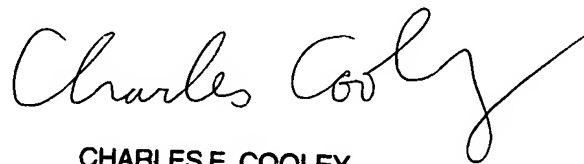
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

David Sorkin

October 29, 2002



CHARLES E. COOLEY  
PRIMARY EXAMINER